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A certified copy of priority document, JP 10-212461, was filed on August 1, 2002. Enclosed is a copy of the first page of the certified priority document and returned mail room postcard which indicates receipt of the certified priority document by the U.S. Patent Office. Also enclosed is a Form 304 which indicates that a certified copy of the priority document was received by the international bureau. Thus, Applicants believe that the submission requirements for the priority document have been satisfied. If, however, the Examiner would prefer, Applicants are willing to provide another certified copy of the priority document.

The cross reference to related applications on page 1 has been amended to indicate in which language the international application published. Thus the specification complies with the requirements of 37 CFR 1.78(a)(2).

Claims 1-28 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants believe that the amendments to claim 1 obviate the instant rejections and request that the rejections be withdrawn.

Claims 1-13, 20, 22, 23, and 25 were rejected under 35 U.S.C. §102(b,e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Harada patent.

Claims 1-5 and 20-28 were rejected under 35 U.S.C. 103(a) as obvious over the Harada patent in view of Allen and Hirose.

Claims 1-19 and 21-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Harada in view of Mizutani.

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For the sake of brevity, the three § 102/103 rejections are addressed in combination. Such a combined response is considered appropriate because *inter alia* each of the rejections relies on the Harada patent as the primary citation.

Each of the rejections is traversed.

A brief description of the present invention may be of assistance in addressing the patentability of the present invention in view of the pending §102 and §103 rejections.

The present invention provides a transparent thermoplastic resin composition which consists essentially of a blend of a transparent aromatic thermoplastic resin and a copolyester of one **aliphatic** diol and two dicarboxylic acid moieties, e.g., the copolymer consists of a mixture of naphthalene dicarboxylic acid, another dicarboxylic acid and one aliphatic diol. The transparent aromatic thermoplastic resin component has a visible light transmittance of not less than 80% when the resin is molded into a 3 mm thick product.

The specification provides that **aliphatic** diols suitable for use in the copolyesters of the invention include alkylene diols and polyalkylene glycols. Moreover, the definition of "aliphatic" from the Merriam-Webster Online dictionary: of, relating to, or being an organic compound having an open-chain structure (as an alkane). Thus, claim 1 provides a transparent thermoplastic resin composition which consists essentially of a blend of a transparent aromatic thermoplastic resin and a copolyester of at least one **aliphatic** diol and two dicarboxylic acid moieties and excludes those resin compositions comprising a copolyester having alicyclic diol repeat units, e.g., non-aliphatic diol repeat units, such as 1,4-cyclohexanedimethanol repeat units.

In contrast, Harada recites copolyesters in which the diol repeat unit is a mixture of ethylene glycol and 1,4-cyclohexanedimethanol repeat units. Thus, Harada fails to recite resin compositions consisting essentially of a transparent aromatic thermoplastic resin and a copolyester of at least one **aliphatic** diol and two dicarboxylic acid moieties. All of the resins recited by Harada comprise at least one non-aliphatic diol, e.g., at least one alicyclic diol.

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As the Office Action is understood, Allen, Hirose and Mizutani are merely cited to show methods of stabilizing polycarbonate/polycarbonate blends and are unable to overcome the structural differences between the resin blends of the invention and the resin compositions of Harada.

Accordingly, claim 1 is patentable over the teachings of Harada, or any combination of Harada, Allen, Hirose, and Mizutani. Claims 2-28 depend from claim 1 and are therefore also patentable over the teachings over the teachings of Harada, or any combination of Harada, Allen, Hirose, and Mizutani.

In view thereof, reconsideration of the application and withdrawal of the §102 and §103 rejections are requested.

For example, see *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978) ("[r]ejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.") Additionally, it is well-known that to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference(s) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143.

There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the cited references to make the claimed invention, nor is there a reasonable expectation of success.

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Claims 1-12 and 22 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending application 09/744,285

U.S. Patent Application 09/744,285 has been allowed to go abandoned. Thus, the provisional rejection of claims 1-12 and 22 under the judicially created doctrine of obviousness-type double patenting should be withdrawn.

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

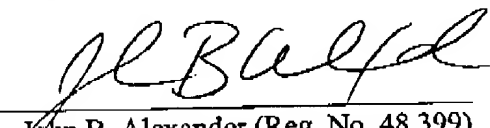
Although it is not believed that any additional fees are needed to consider this submission, the Examiner is hereby authorized to charge our deposit account no. 04-1105 should any fee be deemed necessary.

Respectfully submitted,

Date: April 9, 2003



#330038


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VERSION WITH MARKINGS TO SHOW CHANGES TO CLAIMS

Please note that additions to the claims are shown underlined and deletions are shown in brackets.

IN THE SPECIFICATION:

Kindly amend the Title of the Invention, on page 1, as follows:

THERMOPLASTIC RESIN COMPOSITION COMPRISING A NAPHTHALENE
DICARBOXYLIC ACID MOIETY, MOLDED PRODUCT AND USE

Kindly amend the Cross Reference to Related Application, on page 1, as follows:

This is a continuation-in-part of application serial No. (PCT/JP99/04007), filed July 27, 1999 (international filing date), which international application was published in Japanese.

IN THE CLAIMS:

Kindly amend claim 1, as follows:

1. (presently amended) A thermoplastic resin composition comprising:
a transparent aromatic thermoplastic resin (a) and
a copolyester resin (b) ~~comprising~~ consisting essentially of at least two kinds of dicarboxylic acid moieties and at least one kind of aliphatic diol moiety, 1 to 50 mol% of the dicarboxylic acid moieties being a naphthalenedicarboxylic acid moiety,
the ratio of (a) to the combined amount of (a) and (b) being 55 to 99.99% by weight, and the ratio of (b) being 0.01 to 45% by weight, and
said transparent aromatic thermoplastic resin (a) showing a visible light transmittance of not less than 80% when molded into a 3 mm thick product.

Kindly cancel claim 7 without prejudice or disclaimer.

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COPY**PATENT COOPERATION TREATY****PCT****NOTIFICATION CONCERNING
SUBMISSION OR TRANSMITTAL
OF PRIORITY DOCUMENT**

(PCT Administrative Instructions, Section 411)

From the INTERNATIONAL BUREAU

To:

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Halifax Kudan Building
4th floor
4-4, Kudan-minami 2-chome
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Tokyo 102-0074
JAPON



Date of mailing (day/month/year) 05 October 1999 (05.10.99)	
Applicant's or agent's file reference MP9902	IMPORTANT NOTIFICATION
International application No. PCT/JP99/04007	International filing date (day/month/year) 27 July 1999 (27.07.99)
International publication date (day/month/year) Not yet published	Priority date (day/month/year) 28 July 1998 (28.07.98)
Applicant MITSUBISHI ENGINEERING-PLASTICS CORPORATION et al	

1. The applicant is hereby notified of the date of receipt (except where the letters "NR" appear in the right-hand column) by the International Bureau of the priority document(s) relating to the earlier application(s) indicated below. Unless otherwise indicated by an asterisk appearing next to a date of receipt, or by the letters "NR", in the right-hand column, the priority document concerned was submitted or transmitted to the International Bureau in compliance with Rule 17.1(a) or (b).
2. This updates and replaces any previously issued notification concerning submission or transmittal of priority documents.
3. An asterisk(*) appearing next to a date of receipt, in the right-hand column, denotes a priority document submitted or transmitted to the International Bureau but not in compliance with Rule 17.1(a) or (b). In such a case, the attention of the applicant is directed to Rule 17.1(c) which provides that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity, upon entry into the national phase, to furnish the priority document within a time limit which is reasonable under the circumstances.
4. The letters "NR" appearing in the right-hand column denote a priority document which was not received by the International Bureau or which the applicant did not request the receiving Office to prepare and transmit to the International Bureau, as provided by Rule 17.1(a) or (b), respectively. In such a case, the attention of the applicant is directed to Rule 17.1(c) which provides that no designated Office may disregard the priority claim concerned before giving the applicant an opportunity, upon entry into the national phase, to furnish the priority document within a time limit which is reasonable under the circumstances.

<u>Priority date</u>	<u>Priority application No.</u>	<u>Country or regional Office or PCT receiving Office</u>	<u>Date of receipt of priority document</u>
28 July 1998 (28.07.98)	10/212461	JP	01 Octo 1999 (01.10.99)

The International Bureau of WIPO
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CIP

RZ

Mailing Date: August 1, 2002

Client: 71360

Inventors: Kanayama, et al.

Serial No. 09/768,931

Filing Date: January 24, 2001

Attorney/Sec: JBA/mch

Docket No.: 55551-CIP (71360)

Patent No.:

Grant Date:

The dating stamp of the Patent and Trademark Office hereon will be taken as the date of filing of:

Amendment Transmittal (4 pages):

Amendment (10 pages);

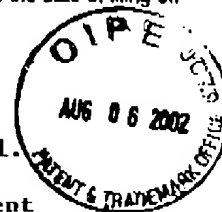
Check in the amount of \$400.00;

Certificate of Mailing by First Class Mail.

Transmittal of Certified Copies (1 page);

Certified copy of Japanese Priority Document
No. 1998-212461

Due Date: A copy of Partial translation of Saturated
Polyester Resin Handbook (5 pages).



COPY 日本国特許庁
JAPAN PATENT OFFICE

別紙添付の書類に記載されている事項は下記の出願書類に記載されて
いる事項と同一であることを証明する。

This is to certify that the annexed is a true copy of the following application as filed
with this Office

出願年月日
Date of Application:

1998年 7月28日

出願番号
Application Number:

平成10年特許願第212461号

[ST.10/C]:

[JP1998-212461]

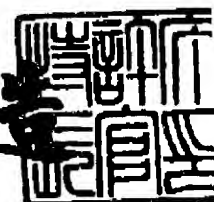
出願人
Applicant(s):

三菱エンジニアリングプラスチックス株式会社

2002年 5月 7日

特許庁長官
Commissioner,
Japan Patent Office

及川耕造



出証番号 出証特2002-303221